Supreme Court, U. S.
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IN THE

Supreme Court of the United States

October Term, 1979

No. 79-526

EDWIN G. BEMIS,

Petitioner,

vs.

CHEVRON RESEARCH COMPANY, STANDARD OIL COMPANY OF CALIFORNIA and STANLEY O. HUTCHISON,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

GILBERT A. THOMAS,
1442 Irvine Boulevard, Suite 119,
Tustin, Calif. 92680,
(714) 832-4300,
Attorney for Petitioner.

Parker & Son, Inc., Law Printers, Los Angeles. Phone 724-6622

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CHEVRON RESEARCH COMPANY, STANDARD OIL COMPANY OF CALIFORNIA and STANLEY O. HUTCHISON,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit entered on July 2, 1979.

Citation to Opinions Below.

The opinion of the United States District Court, Central District of California granting defendant's Motion to Dismiss Plaintiff's Complaint pursuant to Rule 12(b) of the Federal Rules of Civil Procedure is printed in Appendix "A" hereto.

The opinion of the Ninth Circuit Court of Appeals which affirmed the judgment of the United States District Court, Central District of California, is printed in Appendix "B" hereto.

Jurisdiction.

The judgment of the Court of Appeals, printed in Appendix "B" hereto was entered on July 2, 1979. The jurisdiction of this court is invoked under 28 U.S.C. §1254(1).

The Questions Presented.

1. Whether defendants may falsely file for and obtain a patent and deny the true inventor ownership in the patent by the plea that in 35 U.S.C. §256 as interpreted by the courts in *Kennedy v. Hazeltine,* (1888), 128 U.S. 677 and its progeny provides no basis for relief.

2. In interpreting 35 U.S.C. §256 which party must be without deceptive intent? The true inventor, who had no knowledge of or participated in the deceptive acts; or the applicant who was in fact not an inventor but the applicant with full knowledge of the deception, in order to make the remedial effects of the last paragraphs of 35 U.S.C. §256 available to correct an issued patent?

3. Does *Kennedy v. Hazeltine* (1888), 128 U.S. 677, *Rival Mfg. Co. v. Dazey Products Co.,* 358 F. Supp. 91 and their progeny which deny an innocent inventor the right to afford himself the remedial procedures of 35 U.S. §256 so as to substitute his name for that of a deceitful and fraudulent applicant named inventor on an issued patent, violate the U.S. Constitution, Article 1, Section 8, Clause 8 in which Congress was enjoined to secure for limited times to . . . Inventors the exclusive right to their . . . discoveries.

4. Does the decision reached by the District Court and the Appellate Court violate the Fifth Amendment

of the Constitution in that there is a taking of the patent rights of the inventor by a false applicant without due process of law?

Constitutional Provisions, Statutes and Rules Involved.

The Constitutional provisions involved are:

Article I, Section 8, Clause 8 of the Constitution, the due process clause of the Fifth Amendment to the Constitution. The Patent Statutes in 35 U.S.C., particularly 35 U.S.C. §256 and §116. The provisions are printed in Exhibit "C".

Statement.

Petitioner is an individual who was an employee of the defendants, CHEVRON RESEARCH COMPANY and STANDARD OIL OF CALIFORNIA for a number of years. During said employment, EDWIN G. BEMIS disclosed certain information to the defendants that resulted in application U.S.S.N. 150,536 and U.S. Patent 3,720,264 (hereinafter referred to as "264") describing and claiming a method and apparatus for High Pressure Jet Well Cleaning.

Defendants never informed plaintiff that they contemplated filing for a patent using his disclosure. Defendants waited for two years after plaintiff's termination to file patent application U.S.S.N. 150,536 which incorporated plaintiff's invention.

Defendants, CHEVRON RESEARCH COMPANY and STANDARD OIL OF CALIFORNIA conspired with defendant, STANLEY O. HUTCHISON, another employer and former supervisor of EDWIN G. BEMIS, to have him named the inventor on the application and subsequently issued "264" patent. EDWIN G. BE-

MIS was not named as inventor or co-inventor of the "264" patent.

EDWIN G. BEMIS did not discover that the "264" patent claiming his invention had issued until 1974.

No discovery has been taken in this case. Defendants filed a motion to dismiss based on *Kennedy v. Hazeltine* (1888), 128 U.S. 677.

The District Court granted the motion on August 27, 1976. The Ninth Circuit Court of Appeals affirmed the District Court's decision on July 2, 1979.

REASONS FOR GRANTING THE WRIT.

I

This Petition Raises Substantial and Important Questions Concerning the Rights of Inventors to the Fruits of Their Labors Under U.S. Patent Laws. This Case Describes a Situation in Which a Pretender Has Appropriated an Invention by Falsely Filing, Omitting the True Inventor's Name, and Obtaining Issuance of a Patent in the Pretender's Name.

A key provision of U.S. Patent Law, 35 U.S.C. §256 is involved. That section reads as follows:

> "Misjoinder of Inventor.—Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.
>
> Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.
>
> The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court

before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly. (July 19, 1952, c. 950, §1, 66 Stat. 810)."

The Ninth Circuit Court of Appeals found plaintiff, EDWIN G. BEMIS, had raised a novel issue in seeking a remedy in the Patent laws.

Focusing on the words "conspiracy" and "fraud", the Ninth Circuit judges arrived at the conclusion that the presence of these vices as alleged in the complaint would bar the remedy available in 35 U.S.C. §256. They made no inquiry into a number of very important questions. Who, for instance, must be free of deception or fraud in order for the remedial procedure to be operative? Against whom must the deception be directed? The Patent Office, the omitted inventor, the public, others with some property interest in the patent or some combination of the above?

Kennedy v. Hazeltine (1888), 128 U.S. 677, used by defendants to support their argument for dismissal and followed by the District Court and the Court of Appeals, presents a markedly different set of facts when compared to the case at bar. HAZELTINE was guilty of the deception. He hired another to file and receive a patent in his name so that HAZELTINE could avoid assigning the invention to KENNEDY.

Both applicant and inventor were guilty of conspiracy and fraud. Neither party was innocent.

Here, EDWIN G. BEMIS is completely free from fraud or deceit. He did not even know an application had been filed with a false inventor or a patent allowed until a year after the patent had issued.

Kennedy v. Hazeltine (1888), 128 U.S. 677, taught that the patent in issue was void because of inventorship error, caused by fraud and deceit on the part of the true inventor and the patentee. The court after making that finding stated that a court of equity could not order conveyance of a void patent since such would only enable the transferee to "impose upon the public by asserting rights under a void patent."

In this case, the lower court made a determination of inventorship. It never inquired into EDWIN G. BEMIS' innocence or guilt. No 35 U.S.C. §256 investigation was made to determine if EDWIN G. BEMIS was the true inventor, a joint inventor or no inventor at all. No inquiry was made to determine if conspiracy, fraud or innocent mistake was involved. Summary dismissal was granted.

The court in effect stated that inventors could be fraudulently deprived of their invention by their employers if they followed the scheme used by CHEVRON RESEARCH COMPANY.

No consideration of the Constitutional mandate of Article I, Section 8, Clause 8 was discussed by either the District Court or the Court of Appeals. How can this mandate to secure for *inventors* for limited times the exclusive rights to their discoveries be reconciled to a refusal to even consider an innocent inventor's claim, because of the findings of an 1888 case which had a completely different set of facts and was decided prior to the enactment of 35 U.S.C. §256?

Petitioner would argue that *Kennedy v. Hazeltine* is not applicable to this case and the lower courts require instruction from the Supreme Court of the

United States to distinguish it from cases like the present one. To slavishly follow *Hazeltine* has and will result in the future in gross injustice and violation of the Constitutional mandate which had as its objective the protection of inventors.

II

The Courts Below Next Argued That 35 U.S.C. §256, Although Remedial in Nature, Provides for the Substitution of a Misjoined Inventor or Addition of an Omitted Inventor if the Misjoinder or Non-joinder Was "by Error and Without Deceptive Intention."

This is a relatively new section in patent law being a part of the Patent Act of 1952.

Because Article I, Section 8, Clause 8 of the Constitution authorizes an exclusive right in discoveries to inventors and none other, the Patent laws have been construed to grant patents only to true inventors.

A patent, issued to one who erroneously believed he was the only true inventor or to several who believed themselves inventors but one was not, was void.

See *Schreckhise v. Ritchie,* 162 F.2d 593, 595.

To mitigate this hardship, 35 U.S.C. §256 was enacted providing a means for the Commissioner of Patents on application of all the parties or the courts if the matter is brought before them, to correct errors and preserve the validity of patents for true inventors.

The question of who must be free from deceptive intent was not defined by the law or commentators.

Since the purpose of the law is to preserve the validity of patents for true inventors, to fulfill the

Constitutional mandate, should not the law be construed broadly so as to achieve its remedial effect?

The petitioner's case is an appropriate one for the Supreme Court to speak on this issue. Here it is alleged that EDWIN G. BEMIS' employer conspired with his supervisor to obtain a patent on EDWIN G. BEMIS' invention two years after he left their employment. They kept the application and issuance of the patent a secret from the true inventor.

EDWIN G. BEMIS also believes they have filed for and obtained foreign patents based upon his invention and have enriched themselves from its commercialization.

Does not the finding that no remedy exists in the Patent laws result in gross injustice? Should the guilty party be allowed to raise this defense to protect their ill-gotten gains? Would not a finding that CHEVRON RESEARCH COMPANY is equitably estopped from raising the invalidity defense and allow the lower court to make inquiry as to the true inventor be a means to meet the Constitutional mandate?

If the lower court finds EDWIN G. BEMIS the true inventor and if he is innocent of deceptive intention or fraud would not an order of that court correcting the patent under 35 U.S.C. §256 fulfill the spirit of the Constitution and the Patent laws? Would it not also provide increased protection for true inventors and warn those who would conspire to use the laws to their advantage and deprive true inventors of their rights that our courts will not allow a twisted or one-sided application of those laws to permit an injustice?

III

Due Process Requires Fundamental Fairness. In His Commentary on the New Patent Act, P. J. FEDERICO, Examiner in Chief of the Patent Office Stated:

> "The third paragraph of section 256 states that misjoinder or nonjoinder of joint inventors shall not invalidate a patent if the mistake is one that can be corrected under this section, that it arose by error and without deceptive intention and gives the court authority to order such correction."

He stated that the last paragraph dealing with the court's authority to make such corrections is independent and grants the courts independent authority to make inquiry and order corrections of patents issued with errors as to inventorship. 35 U.S.C.A. §1 (1954), 35 U.S.C. §256 note.

Due process of law requires that there be a court determination of questions that may result in the cancelation, revocation or annulment of a property right.

Patents have the attribute of personal property. 35 U.S.C. §261.

In *Iowa State University Foundation v. Sperry Rand Corp.*, 444 F.2d 406 (4th Cir. 1971), the Fourth Circuit stated:

> "Inventorship contests will consinue to be heard in Federal Courts. In numerous instances the courts have been called on to determine whether a patent is the work of a sole or joint inventors. 35 U.S.C. §256 does not substantially change the contest, it does however add an opportunity for correction as an alternative to invalidation."

This decision while stating that due process requires a court determination of patent ownership rights and

that 35 U.S.C. §256 allowed the courts to make that determination without invalidating the patent in question, left a number of questions unanswered.

Who must be free of deceptive intent? Does the true inventor have standing to seek correction although he has only equitable rights in the patent? Can the true inventor seek judicial correction when no action concerning patent infringement is pending?

These questions beg definitive answers by the Supreme Court of the United States and are available for such definition in the EDWIN G. BEMIS case.

IV

Finally There Is a Conflict Among the Circuits as to the Power of the Courts to Substitute One Inventor for Another.

The commentary on the new patent act at 35 U.S.C.A. §50 states:

> ". . . it is not possible under (35 U.S.C. §256) to change a patent issued with A as the sole inventor to one naming B as the sole inventor."

The Federal Court in the Western District of Missouri in *Rival Mfg. Co. v. Dazey Products Co.*, 358 F. Supp. 91 (1973), at page 101 found that:

> "Title 35 U.S.C. §256 is limited to the correction of errors involving true joint inventorship and does not contemplate or permit what would amount to a substitution of one inventor entity for another under the guise of correction."

In 1977, the Court of Appeals for the District of Columbia held in a case of first impression, dealing with 35 U.S.C. §116, a parallel statute to §256, concerning applications in the patent office, that the inventorship in a patent application and in a reissue patent

application could be amended by substituting the name of one sole inventor entity for the name of the original sole inventor entity. *Stoddard v. Dann,* 564 F.2d 556 (D.C. Cir. 1977).

In that decision the court also stated:

> "The Constitution speaks of securing to inventors the exclusive right to their discoveries not that the inventor must apply. The Constitution is result oriented . . . The exclusive public use of an invention can justly be secured by law to no person except its inventor."

Since disagreement and confusion exists among the circuits, this Court, in exercising its supervisory authority over the Federal Judiciary, should grant Certiorari to settle the disagreements and to provide answers to the many questions begging definition involving 35 U.S.C. §256, its companion 35 U.S.C. §116, and true inventors' rights under Article I, Section 8, Clause 8 and the due process clause of the Fifth Amendment.

Conclusion.

The Petition for Certiorari should be granted.

Respectfully submitted,

GILBERT A. THOMAS,

Attorney for Petitioner.

APPENDIX "A."

Notice of Entry.

United States District Court, Central District of California.

Edwin G. Bemis, Plaintiff vs. Chevron Research Company, et al., defendant. Case Number CV76-810-AAH.

To the above named parties and to their attorneys of record;

You are hereby notified that JUDGMENT OF DISMISSAL in the above entitled case was entered in the docket on August 30, 1976.

You are also notified that if this case was tried and you introduced exhibits into evidence, they must be claimed at this office *after* the expiration of thirty days from the receipt of this notice. (*After* sixty days in cases in which the United States, its officers or agencies were parties) Unless they are claimed within thirty days after the expiration of the above period, they will be destroyed pursuant to Local Rule 20(a). If an appeal is taken they will, of course, be held until the Appellate Court finally determines the matter. Exhibits which are attached to a pleading will not be destroyed but will remain as a permanent record in the case file.

CERTIFICATE OF MAILING

I, Edward M. Kritzman, Clerk, United States District Court, Central District of California, and not a party to the within action, hereby certify that on August 30, 1976, I served a true copy of this notice of entry on the parties in the within action by depositing true copies thereof, enclosed in sealed envelopes, in the United States Mail in the United States Post Office

mail box at Los Angeles, California, addressed as follows:

Attn: Charles L. Rogers, Esq.
Messrs. Lawler, Felix & Hall
800 Standard Oil Bldg.
605 West Olympic Blvd.
L.A., CA. 90015

Gilbert A. Thomas, Esq.
17621 Irvine Blvd., Ste. 105
Tustin, CA. 92680

EDWARD M. KRITZMAN, Clerk

By ....., Deputy Clerk

NOTICE

IN ACTIONS ARISING UNDER THE ECONOMIC STABILIZATION ACT, THE EMERGENCY PETROLEUM ALLOCATION ACT, AND THE ENERGY POLICY AND CONSERVATION ACT, NOTICES OF APPEAL TAKEN FROM THIS JUDGMENT MUST BE FILED IN THE TEMPORARY EMERGENCY COURT OF APPEALS IN ACCORDANCE WITH THE RULES OF PROCEDURE OF THAT COURT.

Judgment of Dismissal [F.R.C.P. Rule 54(a)].

United States District Court, Central District of California.

Edwin G. Bemis, Plaintiff, vs. Chevron Research Company, Standard Oil Company of California and Stanley O. Hutchison, Defendants. Civil Action No. CV No. 76 810 AAH.

Filed: Aug. 27, 1976.

The above-entitled cause came on regularly for hearing on August 23, 1976 at 10:00 a.m. before this Court, the Honorable A. Andrew Hauk, United States District Judge, presiding, on motion of defendants, Chevron Research Company, Standard Oil Company of California and Stanley O. Hutchison to dismiss the Complaint pursuant to Rule 12(b) of the Federal Rules of Civil Procedure.

The Court, having read and considered said Motion to Dismiss, the Memorandums of Points and Authorities filed in support thereof, the Memorandum of Points and Authorities filed in opposition thereof, and all of the pleadings, documents and records on file herein, after having heard the comments of counsel appearing on behalf of plaintiffs and the defendants, this Court finds that said Motion to Dismiss should be granted and the Complaint should be dismissed with prejudice. Accordingly:

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that:

A final judgment under Rule 54(a) of the Federal Rules of Civil Procedure be entered in favor of defendants, Chevron Research Company, Standard Oil Company of California and Stanley O. Hutchison, dismissing, with prejudice, the Complaint against them.

DATED: This 27th day of August, 1976.

A. ANDREW HAUK,
UNITED STATES DISTRICT JUDGE

APPROVED AS TO FORM
/s/ Gilbert A. Thomas
Attorney for Plaintiff,
Edwin G. Bemis

DECLARATION OF SERVICE BY MAIL

[U.S. District Court, Central District, Local Rule 5(b)(3)].

Fay Latimer, the undersigned, hereby declares:

Declarant is a citizen of the United States and is employed by the law firm of Lawler, Felix & Hall, 800 Standard Oil Building, 605 West Olympic Boulevard, Los Angeles, California 90015. Declarant is over the age of 18 years and not a party to the within action. On the 24th day of August, 1976, at the direction of Charles L. Rogers of said firm and a member of the bar of the United States District Court for the Central District of California, I served the within JUDGMENT OF DISMISSAL on the attorney(s) of record for the Plaintiff in this matter by mailing, with postage thereon fully prepaid, a true copy thereof to said attorney(s) at their known address, to wit:

Gilbert A. Thomas, Esq.
17521 Irvine Boulevard, Suite 105
Tustin, California 92680

I declare under penalty of perjury that the foregoing is true and correct.

Executed at Los Angeles, California on the 24th day of August, 1976.

/s/ Fay Latimer
Fay Latimer, Declarant

APPENDIX "B."

Opinion.

United States Court of Appeals, for the Ninth Circuit.

Edwin G. Bemis, Plaintiff-Appellant, vs. Chevron Research Company, Standard Oil Company of California, and Stanley O. Hutchison, Defendants-Appellees. No. 76-3597.

Appeal from the United States District Court for the Central District of California.

Filed: July 2, 1979.

Before: WALLACE and TANG, Circuit Judges, and BATTIN,* District Judge.

Per Curiam:

On March 12, 1976, the appellant, Bemis, filed a four-count complaint in the district court. The subject matter of the complaint was United States Patent subject matter of the complaint was United States Patent No. 3720264 (hereinafter, "patent"); the defendants named in the complaint were Hutchison, the named inventor of the method as now protected by the patent, Chevron Research Company, the assignee of the patent, and Standard Oil Company of California. The action was brought pursuant to 28 U.S.C. § 1338(a), as "arising under the Patent Laws of the United States".

The gravamen of the complaint was that Bemis, rather than Hutchison, invented the subject matter of the patent, and that Hutchison conspired with the other two defendants to defraud the Patent Office by filing a false application. By his complaint Bemis prayed that he be found to be the only true inventor of

*The Honorable James F. Battin, United States District Judge for the District of Montana, sitting by designation.

the patent, and that the Court direct the Commissioner of Patents to issue a corrected patent to him in conformity with the requested finding. The defendants moved to dismiss the complaint for failure to state a claim. The district court, upon consideration of the briefs and oral argument, granted the defendants' motion and entered a judgment of dismissal. This is an appeal from that judgment.

The issue raised on appeal is whether the district court erred in its conclusion that the relief sought by the plaintiff is without basis in the statutes governing reissuance of patents and thus whether the court erred in dismissing plaintiff's complaint for failure to state a claim.

The remedy sought by appellant is a novel one. Upon his allegations that the defendants conspired to commit a fraud upon the Patent Office by wrongfully naming Hutchison as the inventor of the patent subject matter, while knowing the patent to have been invented by another, appellant seeks to substitute his name on the patent as inventor in place of Hutchison's. The appellant has premised his right to relief on 35 U.S.C. § 256, which provides, in pertinent part, that:

> Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may . . . issue a certificate deleting the erroneously joined person from the patent.
>
> Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may . . . issue a certificate adding his name to the patent as a joint inventor.

From a close reading of the statute, as well as the legislative history and the case law construing it, the inevitable decision is that § 256 is inapplicable, on the facts of this case to secure to the appellant the relief he requests.

Section 256, though remedial in character is specific in effect and cannot properly be the vehicle for substituting inventors on a patent in a claim sounding in conspiracy and fraud. The Congressional committee report on § 256 clearly demonstrates that the statute remedies only innocent errors in joinder or non-joinder of inventors:

> Section 256 is a new section in the law that is correlated with Section 116 and relates to a mistake in joining a person as a joint inventor. Very often two or three people make an invention together. They must apply as joint inventors. If they make a mistake in determining who are the true inventors they do so at their peril. This provision permits a bona fide mistake in joining a person as inventor to be corrected. H.R. Report No. 1923, 82d Congress, 2d Sess. (1952)

The *Commentary on the New Patent Act,* which preceded the text of Title 35 in United States Code Annotated, explains that, while § 256 permits the deletion of a person named in a patent as a joint inventor or the addition of a person who is in fact a joint inventor, it does not reach to the substitution of one sole inventor for another.

> . . . It would not be possible under this section to change a patent which was issued with A

as the sole inventor to one naming B as the sole inventor. 35 U.S.C.A. at 50.

Further, the Western District of Missouri, in *Rival Mfg. Co. v. Dazey Products Co.*, 358 F.Supp. 91 (W.D. Mo. 1973), found that:

> Title 35, U.S. Code, Section 256, is limited to the correction of errors involving true joint inventorship and does not contemplate or permit what would amount to a substitution of one inventor entity for another under the guise of "correction". . . . *Rival Mfg. Co.*, 358 F.Supp. at 101.

The allegations of the complaint in this case fail to meet the statutory conditions pursuant to which patents may be amended or corrected. Paragraph 6 of the complaint alleges that:

> 6. On June 7, 1971, defendant, HUTCHISON, conspired with defendants, CHEVRON RESEARCH and STANDARD OIL to falsely and fraudulently sign an oath declaring himself the only true inventor of the METHOD AND APPARATUS FOR HIGH PRESSURE JET WELL CLEANING and assigned such invention to CHEVRON RESEARCH COMPANY which was United States Application No. 150,36.

Section 256 requires that the acts giving rise to the need for amendment or correction be inadvertent, brought about "by error and without deceptive intention". Clearly, the allegations of the complaint are well without the circumstances for which § 256 was designed as a remedy. The appellant has failed to allege either joint ownership or innocence. In fact, his complaint alleges the opposite. Insofar as Bemis can prove no set of facts in support of his claim

that will entitle him to the relief he has requested. *Conley v. Gibson*, 355 U.S. 41 (1957), it is evident that the district court properly dismissed the complaint for failure to state a claim.

Affirmed.

APPENDIX "C."

Constitution of the United States of America, Amendment 5 Criminal Actions—Provisions Concerning —Due Process of Law and Just Compensation Clauses.

No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offense to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

35 U.S.C. §256.

256. Misjoinder of Inventor: Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other

requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly. (July 19, 1952, c. 950, §1, 66 Stat. 810).

35 U.S.C. §116.

Joint Inventors: When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes. (July 19, 1952, c. 950, §1, 66 Stat. 799.)

Supreme Court, U. S.
FILED
OCT 30 1979
MICHAEL RODAK, JR. CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-526

EDWIN G. BEMIS, *Petitioner,*

v.

CHEVRON RESEARCH COMPANY,
STANDARD OIL COMPANY OF CALIFORNIA and
STANLEY O. HUTCHISON, *Respondents.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

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BRIEF FOR RESPONDENTS IN OPPOSITION

WILLIAM L. MATHIS
REGIS E. SLUTTER
BURNS, DOANE, SWECKER & MATHIS
George Mason Building
Washington & Prince Streets
Alexandria, Virginia 22312

Counsel for Respondents

Of Counsel:

CHARLES L. ROGERS
LAWLER, FELIX & HALL
700 South Flower Street
Los Angeles, California 90017

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-526

EDWIN G. BEMIS, *Petitioner*,

v.

CHEVRON RESEARCH COMPANY, STANDARD OIL COMPANY OF CALIFORNIA and STANLEY O. HUTCHISON, *Respondents*.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

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BRIEF FOR RESPONDENTS IN OPPOSITION

OPINION BELOW

The opinion of the Court of Appeals for the Ninth Circuit (Pet., A. 5-9) is reported at 599 F.2d 910.

JURISDICTION

The jurisdictional requisites are adequately set forth in the Petition.

QUESTION PRESENTED

Whether the statutory provisions for correcting inventorship joinder errors made innocently in patent applications provide a basis for a court award of a patent to a plaintiff who never made an application to the Commissioner of Patents but who claims nevertheless that he is entitled to the patent granted to the defendant on an application which, according to plaintiff, fraudulently named the defendant as the sole inventor when defendant knew that plaintiff was the sole inventor.

CONSTITUTIONAL PROVISION AND STATUTE INVOLVED

Although it appears that petitioner intended to include Const., art. I, § 8, cl. 8 in his appendix, it did not appear. It is reproduced in Appendix A hereto. Section 256 of Title 35, United States Code, is set forth in the Petition (Pet., A. 10-11).

STATEMENT

The complaint[1] in this case was dismissed by the district court on a motion under Rule 12(b), Fed. R. Civ. P. No attempt to amend the complaint ever was made by the petitioner.

The per curiam opinion of the United States Court of Appeals for the Ninth Circuit concluded "it is evident that the district court properly dismissed the complaint for failure to state a claim." (Pet., A. 9).

[1] The text of the complaint is printed in Appendix B hereto.

The Statement (Pet. 3,4) presented on behalf of the petitioner recites matter which is not true,[2] and it is not supported by the complaint which formed the basis of the actions taken by the courts below.[3]

Only federal question jurisdiction was asserted in the district court. According to paragraph 1 of the complaint (A. 2a), the civil action was said to arise under "the Patent Laws of the United States".

The subject matter of the complaint was United States Patent No. 3,720,264, which was granted by the Commissioner of Patents to respondent Chevron Research Company as assignee of respondent Mr. Hutchison, the individual named as sole inventor in the application for the patent.

The complaint alleged that petitioner, Mr. Bemis, (rather than respondent, Mr. Hutchison) was the actual sole inventor of the subject matter of the patent and that the several defendants had conspired to fraudulently obtain the patent naming Mr. Hutchison as inventor. The complaint did not allege that any of the

[2] Contrary to the assertion (Pet. 4) that no discovery has been taken in this case, an extensive discovery deposition of Mr. Bemis (the petitioner here) was taken. The substance of this testimony is inconsistent with recitations in Petitioner's Statement.

[3] Petitioner's complaint did not include allegations: (a) that an employment relationship existed between the petitioner and any of the respondents; or (b) that the petitioner disclosed information to any of the respondents; or (c) that the respondents did not inform the petitioner about something; or (d) that a period of waiting occurred before respondents filed the application for the patent; or (e) that the application for the patent was filed after petitioner's termination; or (f) that Mr. Hutchison was ever a supervisor of the petitioner; or (g) that the petitioner did not discover that the patent had issued until 1974.

respondents prevented Mr. Bemis from making an application to the Commissioner of Patents for the grant of a patent to Mr. Bemis. Nor was there any allegation that Mr. Bemis had been charged with infringement of the patent.

What was sought by the complaint was a judgment that would cause the patent to be changed to name petitioner Bemis as sole inventor and place Mr. Bemis in the posture of sole owner of the patent. The petitioner has made it clear that he did not wish to obtain a declaration of invalidity of the patent grant obtained from the Commissioner of Patents as a result of allegedly fraudulent acts knowingly committed by the defendants.

The claim of ownership in the patent on the part of the petitioner stemmed solely from the contention that the petitioner was "the true inventor" of the invention covered by the patent. There was no allegation that the petitioner acquired an interest by way of contract rights or by way of being a joint inventor with Mr. Hutchison of the patented invention.

In the courts below, the petitioner premised his right to relief on 35 U.S.C. § 256 (Pet., A. 10, 11) which relates to possibilities for correcting issued patents, rather than patent applications, wherein certain errors had been made without deceptive intention. The errors mentioned in section 256 are (a) characterizing a person as a joint inventor in the patent application when he did not have the legal status of joint inventor and (b) failing to name in the patent application a person who did not have the legal status of joint inventor.

The court of appeals considered in detail both the terms of section 256 and its legislative history but concluded "the inevitable conclusion is that section 256 is inapplicable, on the facts of this case, to secure to the appellant the relief he requests." *Bemis* v. *Chevron Research Company,* 599 F.2d 910, 912 (9th Cir. 1979).[4]

REASONS WHY THE PETITION SHOULD BE DENIED

This Case Does Not Involve a Federal Law Issue of Sufficient Importance to Justify Exercise of the Court's Discretionary Jurisdiction

Whatever may be the importance to the petitioner of this case, it is clear that the petitioner is not entitled, as a matter of right, to another review of his contentions. Review by this Court is discretionary and should not ordinarily be granted with respect to matters which are of limited interest except to the actual litigants.[5]

In assessing the importance of a matter, it is appropriate to consider the probable frequency with which similar questions might arise. An issue which need never arise again can hardly be said to be one which it would be important for the Court to resolve.[6]

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[4] The text of the court of appeals opinion in the Petition (Pet., A. 7) contains some apparent printing errors not believed to be material here.

[5] "[T]he Court does not sit to satisfy a scholarly interest in . . . issues. Nor does it sit for the benefit of the particular litigants. [Citations omitted]. 'Special and important reasons' imply a reach to a problem beyond the academic or the episodic." *Rice* v. *Sioux City Memorial Park Cemetery,* 349 U.S. 70, 74 (1955).

[6] *Id.* at 76, 77.

Such is the case here. Analysis will show that the expansive construction the petition has sought for 35 U.S.C. § 256 is quite unnecessary for the ordinary operation of the patent system to accomplish its legitimate social goals.

True inventors who desire to avail themselves of the benefits of the patent system can apply directly to the Commissioner of Patents for the grant of the rights they seek. There is no need for them to ask a court to give them the patent rights which the Commissioner of Patents has granted on an application made by another person who solemnly asserted he was the true inventor. Adverse claims of inventorship by two different individuals are assigned by statute [7] to the Commissioner of Patents for administrative resolution in the first instance, not the federal courts.

The point may be illustrated further by reference to the situation postulated in the complaint in this case. If the petitioner had been a true inventor entitled to the grant of a patent, he could have obtained that grant by making a timely and proper application [8] to the Commissioner of Patents. Nothing allegedly done by the respondents here would have barred such a grant. Rather, the appearance of a proper application for patent on behalf of petitioner would have caused the

[7] Sections 135(a) and (b) of Title 35, United States Code, pertain to the proceedings which Congress intended to be conducted by the Patent Office in dealing with interfering claims to patent rights on the same invention.

[8] The particulars of a carefully defined network of statutory requirements regarding the timing and content of patent applications presented to the Commissioner are provided by 35 U.S.C. §§ 101, 102, 111-115. Congress has conditioned the availability of lawful patent monopolies upon compliance with these requirements.

Commissioner to institute the type of interference proceeding Congress has selected as appropriate for dealing with conflicting inventorship claims.

There is no cause and effect relationship between an error made by one party in applying for a patent and another party's lack of ownership of a valid patent. Specifically, the acts of respondents in allegedly obtaining a patent improperly did not *cause* the petitioner to be without a patent. If petitioner really was a true inventor entitled to obtain patent rights under the law, the cause of petitioner's lack of a patent is his own failure to even apply to the Commissioner of Patents for the grant of a patent.

It should not be expected that, in the future, many inventors who are genuinely interested in obtaining the benefits of the patent system will seek, for legitimate reasons, to obtain patent rights without, as Congress obviously intended, making applications therefor to the Commissioner of Patents. That is, not many inventors should be seeking to present their requests for patent rights to the federal courts rather than to the Patent Office. Hence it is not important for this Court to study questions as to whether section 256 might in some circumstances provide a basis for sidestepping both the Patent Office and the requirements imposed by Congress upon applications made by inventors to the Commissioner of Patents.

Although section I of the argument in the Petition contains a heading which claims importance for aspects of this case, the text of that section appears to be largely a re-presentation of the arguments on the merits made in the courts below. There is no compilation of data that suggests widespread importance. Nor can

there be. The case simply does not involve a situation which has been troublesome in the past or which is likely to arise frequently in the future.

None of the Petition's Four "Questions Presented" Contains a Genuine Issue Appropriate for Review by the Court in This Case

Petitioner's Question One

No genuine issue is presented by this question.

It has been explained above that a cause and effect relationship, suggested in the petitioner's question one, between the alleged acts of the respondents and the alleged loss to the petitioner, simply does not exist.

The reference to *Kennedy* v. *Hazeltine,* 128 U.S. 677 (1888), in petitioner's question one also is incorrect. That case does not purport to interpret section 256. It was decided long prior to the enactment in the early 1950's of the statutory provision cited in petitioner's question one. Moreover, it should be noted that the opinion (Pet., A. 5-9) setting forth the appellate court decision for which review is sought by the petitioner does not even cite, much less rely upon, the case.

Petitioner's Question Two

Whatever may be the real thrust of this seemingly general question, it is vitiated by the fact that the question recites a factual hypothesis not set forth in the complaint in this case. The complaint does not allege that the plaintiff was free of deceptive intent or that he had no knowledge of the allegedly deceptive application to the Commissioner of Patents or that he avoided participation in deceptive acts.

No issue grounded upon this unpleaded factual hypothesis could be appropriate for consideration by the Court on review.

Petitioner's Question Three

The comments offered above in that portion of the discussion of question one concerning *Kennedy* v. *Hazeltine* are applicable here as well.

Further, no genuine issue is raised by the suggestion that the Constitution somehow bars interpretation of section 256 in a manner unfavorable to petitioner. There is nothing in U.S. Const., art. I, § 8, cl. 8, which requires Congress to enact legislation vesting exclusive rights in an inventor without regard to whether the inventor makes a timely and proper application to the proper authorities for the grant of a patent. Yet the petitioner's third question requires that this constitutional provision be read as if it contained such a requirement.

Petitioner's Question Four

The suggestion of a due process issue is misplaced.

Nothing in the complaint supports a contention that petitioner has been deprived of any patent property. No patent has been taken away from petitioner. He never applied for a patent on the invention of Patent No. 3,720,264 and he never owned or otherwise possessed such a patent.

The proceedings below have given the petitioner every opportunity that could be considered reasonable. He has been heard on all his contentions and both of the lower courts gave careful study to every aspect of the case properly before them. Petitioner's lack of

success in his effort to take away the Hutchison patent cannot be twisted into a legitimate contention that petitioner has been deprived of property without due process of law.

There Is No Conflict of Decisions Justifying Grant of the Petition

Although section IV of the argument in the Petition contends there is a "conflict among the circuits" which justifies the grant of the petition for certiorari, the cases cited do not reveal any conflict of appellate decisions on an issue raised by the complaint in this case.

The only appellate court decision referred to in section IV of the Petition is *Stoddard* v. *Dann,* 564 F.2d 556 (D.C. Cir. 1977). (Pet. 11, 12). It involved a situation wholly different from that presented by the present case and a statutory provision other than the one relied upon by the petitioner in the courts below.

In *Stoddard,* unlike the situation here, there were no private parties claiming adverse interests. The case involved only the power of the Commissioner of Patents to correct an inventorship designation in a situation where there was agreement among the parties not only about who had the legal status of inventor but also about the innocent character of an error which had led to an initially incorrect designation in the patent application.

The statutory provision involved in *Stoddard* was 35 U.S.C. § 116. (Pet., A. 11). Section 116 is in Chapter 11 of the patent statute [9] which pertains to the

[9] Patent Act of July 19, 1952, Pub. L. 593, 82d Cong., 2d Sess., ch. 950; 66 Stat. 792 (codified at 35 U.S.C.). Chapter 11 of the Patent Act begins with section 111.

application that must be made to the Commissioner of Patents to obtain a patent grant. Section 111 [10] begins with the requirement: "Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner" and concludes with some requirements as to the contents of patent applications. Further information about the application required to be made to the Commissioner of Patents is provided in sections 112-115 [11] and by the first two paragraphs of section 116. The last paragraph of section 116, the one involved in *Stoddard,* gives the Commissioner the power to permit, "under such terms as he prescribes," amendments of patent applications to correct certain innocently made inventorship designations errors. The holding in *Stoddard* was that the Commissioner under certain circumstances may change an inventorship designation from one person to another in a patent application filed by the true party in interest.

What the petitioner seems to value *Stoddard* for is its willingness to construe a statutory provision relating in terms to inventorship joinder matters as reaching to situations involving the substitution of a designation of one sole inventor for a previous designation of another sole inventor. Petitioner asserts that the statutory provision involved in *Stoddard* is "parallel" (Pet. 11) to the different statutory provision he relies upon in this case, and that a similar construction should be placed upon the statute of direct interest here.

Stoddard was decided after the main briefs were filed in the Court of Appeals for the Ninth Circuit, but

[10] 35 U.S.C. § 111.

[11] 35 U.S.C. §§ 112-115.

it was brought to the attention of the court through supplemental filings and much of the oral argument of the petitioner was concerned with *Stoddard.* Although the petitioner's contentions were fully presented to the court below, they were not found persuasive and no discussion of *Stoddard* was included in the opinion of the court. Nor was such a discussion necessary, for *Stoddard* expressly disclaims any intent to deal with situations of the type involved in this appeal. *Id.* at 565 n.11.

Thus, with regard to the precise situation actually presented here, there is no evidence of even a divergence of opinion between the District of Columbia Circuit and the Ninth Circuit, much less the type of conflict of decisions that might make it appropriate for this Court to accept petitioner's invitation to review this case. And, even if one assumed the existence of a divergence of views on the applicability of inventorship joinder statutes to inventorship substitution attempts, it is by no means clear that this question ever would be reached in disposing of this case.[12] The Court would not get to that question unless it at least found (1) that the statutes make it proper for the federal courts, rather than the Commissioner of Patents, to initially hear issues of the type sought to be raised here and (2) that the failure to plead a case involving error without deceptive intention was not fatal to petitioner's case.

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[12] Even in those situations which involve real conflicts among the Courts of Appeal, this Court ordinarily confines use of its discretionary jurisdiction to cases where the troublesome questions must be dealt with judicially to provide a proper adjudication. *The Monrosa* v. *Carbon Black Export, Inc.,* 359 U.S. 180, 184 (1959).

In summary, there is no conflict of appellate decision which would make this case a proper one for consideration by the Court.

CONCLUSION

For the foregoing reasons it is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted,

WILLIAM L. MATHIS
REGIS E. SLUTTER
BURNS, DOANE, SWECKER & MATHIS
George Mason Building
Washington & Prince Streets
Alexandria, Virginia 22312

Counsel for Respondents

Of Counsel:

CHARLES L. ROGERS
LAWLER, FELIX & HALL
700 South Flower Street
Los Angeles, California 90017

APPENDIX

APPENDIX A

U.S. Const., Art. I, § 8, Cl. 8

The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

APPENDIX B

IN THE UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Civil Action No. 76 810 AAH

EDWIN G. BEMIS, *Plaintiff*,

vs.

CHEVRON RESEARCH COMPANY, STANDARD OIL COMPANY OF CALIFORNIA, and STANLEY O. HUTCHISON, *Defendants*.

Complaint for Conspiracy, Fraud and Misrepresentation in Procurement of U.S. Patent 3720264 and Damages

FIRST CAUSE OF ACTION

Plaintiff complains against Defendants and for a first claim for relief alleges:

1. This action arises under the Patent Laws of the United States and this Court has jurisdiction thereof under Title 28 U.S.C. § 1338(a).

2. Plaintiff, EDWIN G. BEMIS, is a resident of Los Angeles County, State of California, having a place of residence at 1357 La Serena Drive, Brea, California.

3. Defendant, CHEVRON RESEARCH COMPANY, is a subsidiary of the STANDARD OIL COMPANY OF CALIFORNIA and has a place of business within this Judicial District.

4. Defendant, the STANDARD OIL COMPANY OF CALIFORNIA, is a California Corporation and has a place of business within this Judicial District.

5. Defendant, STANLEY O. HUTCHISON, is a resident of San Francisco, State of California, and is an employee of STANDARD OIL COMPANY OF CALIFORNIA.

6. On June 7, 1971, defendant, HUTCHISON, conspired with defendants, CHEVRON RESEARCH and STANDARD OIL to falsely and fraudulently sign an oath declaring himself the only true inventor of the METHOD AND APPARATUS FOR HIGH PRESSURE JET WELL CLEANING and assigned such invention to CHEVRON RESEARCH COMPANY which was United States Application No. 150,536.

7. On March 13, 1973, United States Patent 3,720,264, for the METHOD AND APPARATUS FOR HIGH PRESSURE JET WELL CLEANING, was issued to STANLEY O. HUTCHISON of San Francisco, California and assigned to CHEVRON RESEARCH COMPANY of San Francisco, California by the United States Patent Office.

8. On information and belief, Defendants caused divisional and foreign patent applications to be filed and foreign patents have issued based upon the false oath and Application No. 150,536.

9. Defendants and each of them know that EDWIN G. BEMIS was the true inventor of the above METHOD AND APPARATUS FOR HIGH PRESSURE JET WELL CLEANING, and by such false oath and application in violation of 35 U.S.C. 115, fraudulently procured the resultant U.S. Patent 3,720,264 and divisional patents related thereto in their own names and for their own benefit and profit.

10. The issuance of U.S. Patent 3,720,264, in the name of HUTCHISON and assigned to CHEVRON has caused plaintiff, the true inventor thereof, to lose reputation and notority in his business and income loss in excess of $75,000.00 annually.

SECOND CAUSE OF ACTION

Plaintiff complains against Defendants and for a second claim for relief alleges:

11. Plaintiff incorporates paragraphs 1 through 9 of his First Cause of Action against defendants and makes such paragraphs a part hereof.

11. Defendants conspired to use U.S. Patent 3,720,264, divisional patents and foreign patents derived therefrom for their own gain and profit and have so used them in their own business without payment of any compensation to plaintiff.

THIRD CAUSE OF ACTION

Plaintiff complains against Defendants and for a third claim for relief alleges:

13. Plaintiff incorporates paragraphs 1 through 9 of his First Cause of Action against defendants and makes such paragraphs a part hereto on information and belief.

14. Defendants conspired together to license and sell rights under U.S. Patent 3,720,264, divisional patents and foreign patents based thereon to others and have obtained compensation royalties and other unjust enrichment for themselves which monies are rightfully plaintiff's.

FOURTH CAUSE OF ACTION

Plaintiff complains against Defendants and for a fourth claim for relief alleges:

15. Plaintiff incorporates paragraphs 1 through 9 of his First Cause of Action against defendants and makes such paragraphs a part hereto.

16. The action of defendants and each of them in conspiring together to deprive plaintiff of rightful ownership of the invention described in U.S. Patent 3,720,264, divisional U.S. Patent and foreign Patents and improvements derived therefrom have caused plaintiff extreme emotional and mental distress which has interferred with the conduct of his business and personal affairs.

WHEREFORE, Plaintiff demands:

1. On his first claim for relief:

a. That the Court find him the only and true inventor of U.S. Patent 3,720,264, divisional and foreign patents

issued therefrom; and direct the Commissioner of Patents to issue a corrected Patent showing plaintiff as the only inventor thereof;

b. That defendants be ordered to sign all documents to transfer title to all foreign patents and patent applications based on U.S. 3,720,264 and other patents found by the court to be divisional patents thereof;

c. Plaintiff be awarded damages of $225,000.00;

2. On his second claim for relief:

a. Defendants be ordered to account to plaintiff for all of their use of Plaintiff's invention as described in U.S. Patent 3,720,264, divisional and foreign patents based thereon in their business and to pay plaintiff a reasonable royalty for such use;

3. On his third claim for relief:

a. Defendants be ordered to account for all compensation, royalties, rents, monies or other unjust enrichment received by reason of the licensing or other commercialization of U.S. Patent 3,720,264, divisional patents and foreign patents related thereto and to pay such monies with interest from the date of receipt thereof to plaintiff;

4. On his fourth claim for relief:

a. Plaintiff be awarded $100,000.00;

5. That plaintiff be awarded exemplary damages in the amount of $1,500,000.00;

6. Plaintiff be awarded reasonable attorneys fees;

7. Plaintiff be allowed his costs; and

8. Such other and further relief be granted to which plaintiff may be justly entitled.

DATED: 3-12-76

/s/ GILBERT A. THOMAS
Gilbert A. Thomas
Attorney for Plaintiff